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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,625	08/31/2001	Joseph Arruda	17853-039	2365
30623	7590	11/08/2006	EXAMINER LUU, MATTHEW	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			ART UNIT 3663	

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,625

Applicant(s)

ARRUDA ET AL.

Examiner

LUU MATTHEW

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26,28-32 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26,28-32 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 36, the new added limitation "the retractable tip movable between a first normal position retracted fully inside the cap..." was not fully described in the specification as originally filed. There is nowhere in the original specification requires the retractable tip has to be "fully inside the cap". There is nowhere in the original specification discloses how exactly the retractable tip is retracted "fully inside the cap". There is nowhere in the original specification discloses what mechanical feature that cooperates with the cap to maintain the tractable tip to be retracted "fully inside the cap".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moller et al (5,889,512) in view of Hazzard (5,913,629).

Claim 36.

Moller discloses (Fig. 9) a cap (a rear portion 18, which includes an extension member 48 with a cap 60) (hereinafter, the rear portion 18), the cap comprising:

a first end (a screw thread aperture 42) for positioning over an end (thread bore 38) of an instrument (the grip portion 16 with the pen tip 20); and

a second end having an aperture (central aperture 44), the aperture (44) having a non-writing retractable tip (an extension member 48 with a cap 60) mounted therein.

The retractable tip (an extension member 48 with a cap 60) movable between a first normal position retracted within the second aperture (Fig. 13) and a second extended position extending out of the second aperture (Fig. 15). See column 6, lines 35-47; and column 7, lines 37-38 and 62-65.

Moller fails to explicitly teach that the retractable tip (48 and 60) being adapted for use with a touch sensitive display.

However, it is obvious to a person of ordinary skill in the art to recognize that a user can use any pointing devices, such as a normal pen, a pencil, or even a finger to input information into a graphics user interface display device by touching a touch sensitive screen. Therefore, the retractable tip of Moller can function equivalently to a touch stylus for interfacing with the touch screen.

Furthermore, the claim limitations that employ phrases of the type "ADAPTED TO", "CAPABLE OF", SUFFICIENT TO', AND 'FOR' doing something are typical of claim limitations, which may not distinguish over the prior art. It has been held that the recitation that an element is "adapted to" perform or is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Regarding the new added limitation, "the retractable tip movable between a first normal position retracted fully inside the cap", Hazzard (5,913,629) discloses (Figs. 1, 4 and 5) both of the writing tip (34) and the tip (actuator button 48) of the cap (upper barrel portion 14a) are fully retracted inside the elongated body (lower barrel portion 14b) and the cap (upper barrel portion 14a), respectively.

Therefore, it would have been obvious to the person of ordinary skill in the art to incorporate the teaches of "fully retracted tip" into the Moller's pen since it is well-known in the art that most of the pen or fountain pen having retractable tip, which can be movable inside the body of the pen for protection when the pen is not in use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 28 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiroyuki (JP11-154052A) in view of Moller and Hazzard (5,913,629).

Claim 36.

Shiroyuki discloses (Figs. 1 and 3) a cap for an instrument, the cap comprising:
a first end (12) for positioning over an end of the instrument (15); and
a second end (10) having an aperture, the aperture having a non-writing tip (11) mounted therein, the tip being adapted for use with a touch sensitive display (Fig. 5, PDA 20). See page 8, sections 11-12; page 10, sections 19-20 ; page 12, sections 24-26.

The only difference between the disclosure of Shiroyuki and the claimed invention is that claim 36 requires the tip (11) is retractable.

However, Moller discloses (Figs 1 and 2) a retractable tip (14) movable between a first normal position within the aperture (Fig. 1) and a second extended position (Fig. 2) extending out of the aperture (Column 4, lines 47-64).

Therefore, it would have been obvious to the one of ordinary skill in the art to use the teaching of the retractable tips of Moller into the cap tip of Shiroyuki since it is well-

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known in the art that most of the pen or fountain pen having retractable tip, which can be movable inside the body of the pen for protection when the pen is not in use.

Regarding the new added limitation, "the retractable tip movable between a first normal position retracted fully inside the cap", Hazzard (5,913,629) discloses (Figs. 1, 4 and 5) both of the writing tip (34) and the tip (actuator button 48) of the cap (upper barrel portion 14a) are fully retracted inside the elongated body (lower barrel portion 14b) and the cap (upper barrel portion 14a), respectively.

Therefore, it would have been obvious to the person of ordinary skill in the art to incorporate the teaches of "fully retracted tip" within the body of the pen since it is well-known in the art that most of the pen or fountain pen having retractable tip, which can be movable inside the body of the pen for protection when the pen is not in use.

Claim 26.

Shiroyuki discloses (Figs. 1 and 3) a writing instrument (15) for alternatively writing on a surface and for interfacing with a touch sensitive display (20), the writing instrument (15) comprising:

an elongated body (15) having a first end having a writing tip (Fig. 4, tip 16) and a second end (18); and

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a cap (Fig. 3, cap 8) having a first end (12) adapted to receive the first end (16) of the elongated body (15) and also adapted to receive the second end (Fig. 4, second end 18) of the elongated body (15);

the cap (8) also having a second end (10) having an aperture, the aperture having a non-writing tip (11) mounted therein, the tip being adapted for use with a touch sensitive display (Fig. 5, PDA 20). See page 8, sections 11-12; page 10, sections 19-20 ; page 12, sections 24-26.

Shiroyuki fails to disclose a "retractable tip ", wherein the second end of the elongated body cooperates with the cap to extend the non-writing tip outwardly from the second aperture as the cap (8) receives the second end (18) of the elongated body (15) as shown in Fig. 4 of Shiroyuki.

However, Moller discloses (Fig. 9) a cap (a rear portion 18, which includes an extension member 48 with a cap 60) (hereinafter, the rear portion 18), the cap comprising:

a first end (a screw thread aperture 42) for positioning over an end (thread bore 38) of an instrument (the grip portion 16 with the pen tip 20); and

a second end having an aperture (central aperture 44), the aperture (44) having a non-writing retractable tip (an extension member 48 with a cap 60) mounted therein. The retractable tip (an extension member 48 with a cap 60) movable between a first normal position retracted within the second aperture (Fig. 13) and a second extended position extending out of the second aperture (Fig. 15). See column 6, lines 35-47; and column 7, lines 37-38 and 62-65.

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Therefore, it would have been obvious to the one of ordinary skill in the art to use the teaching of the retractable tips of Moller into the cap tip of Shiroyuki since it is well-known in the art that most of the pen or fountain pen having retractable tip, which can be movable inside the body of the pen for protection when the pen is not in use.

Claim 28.

The rubber made material of the non-writing tip is an obvious design choice. Furthermore, it is desirable to make the stylus tip from rubber material to reduce friction to the touch screen, provide more light-weight, and reduce manufacture cost.

Claim Rejections - 35 USC § 103

Claims 29-32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiroyuki in view of Moller as applied to claim 26 above, and further in view of the Admitted Prior Art (A.T. Cross) (Specification, page 2, lines 22-32).

Claim 29.

Regarding claim 29, Shiroyuki fails to teach a source for generating a signal for remotely communication with a personal digital device.

However, A.T. Cross teaches the Crosspad, which converts handwritten documents into electronic form. This Crosspad includes a conventional notepad combined with a unique pen and printed circuit board assembly (PCBA) for the notepad. A.T. Cross also teaches "the pen includes a RF transmitter. The RF transmitter

operates in conjunction with the PCBA for the pad to translate pen movement into electronic signals representing the user's writing motion" (Specification, page 2, lines 26-28).

It would have been obvious to the person of ordinary skill in the art to use the RF transmitter source in the pen of the Crosspad into the stylus pen of Shiroyuki to provide a more convenient stylus input device. Furthermore, the stylus pen includes the RF transmitter source for generating signal is well known in the art. Shiroyuki discloses the notepad (20) is a personal digital device.

Claim 30.

A.T. Cross further teaches "A switch in the pen turns the transmitter on when the pen is in contact with the pad. The switch is activated as a result of the force exerted by the pad on the tip of the pen" (Page 2, lines 28-30).

Claim 31.

A.T. Cross teaches "The pen has an ink tip which can be used to make marks on the pad" (Page 2, lines 25-26). Furthermore, the ink supply positioned in the body of the pen is well known in the art.

Claim 32.

Since A.T. Cross teaches "A switch in the pen turns the transmitter on when the pen is in contact with the pad", it would have been obvious to the person of ordinary skill

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in the art to recognize that the transmitter of A.T. Cross is an electromechanical transmitter.

Claim 37.

Regarding claim 37, Shiroyuki further discloses (Fig. 3) wherein the second end (18) of the elongated body (15) is closed.

Response to Arguments

Applicant's arguments filed September 1, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the retractable tip (14) of the cap (18) of Moller can not be used for the tip (11) of the cap (8) of Shiroyuki, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, it is well-known in the art that most of the pen or fountain pen having retractable tip, which can be movable inside the body of the pen for protection when the pen is not in use. For example, Hazzard (5,913,629) discloses (Figs. 1, 4 and 5) both of the writing tip (34) and the tip (actuator button 48) of the cap (upper barrel

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portion 14a) are fully retracted inside the elongated body (lower barrel portion 14b) and the cap (upper barrel portion 14a), respectively.

Applicant further equates the cap (18) of Moller for the cap (8) of Shiroyuki. However, the examiner respectfully disagrees since the examiner only use Moller to show there is a retractable tip (14) inside the cap (18) of Moller. Therefore, the retractable tip.(14) of Moller can be used for the tip (11) of Shiroyuki to make the tip (11) can be retractable for the tip protection when the tip is not in use.

Applicant further argues, at page 5 (second paragraph), by asserting that the cap (18) of Moller is not adapted to receive the elongated body. The examiner respectfully disagrees. Moller was not used to teach this limitation, but the Shiroyuki reference did.

Shiroyuki discloses (Figs. 1 and 3) a writing instrument (15) for alternatively writing on a surface and for interfacing with a touch sensitive display (20), the writing instrument (15) comprising:

- an elongated body (15) having a first end having a writing tip (Fig. 4, tip 16) and a second end (18); and

- a cap (Fig. 3, cap 8) having a first end (12) adapted to receive the first end (16) of the elongated body (15) and also adapted to receive the second end (Fig. 4, second end 18) of the elongated body (15);

- the cap (8) also having a second end (10) having an aperture, the aperture having a non-writing tip (11) mounted therein, the tip being adapted for use with a touch

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sensitive display (Fig. 5, PDA 20). See page 8, sections 1-2; page 10, sections 19-20 ; page 12, sections 24-26.

Regarding claim 36 and the new added limitation, "the retractable tip movable between a first normal position retracted fully inside the cap", Hazzard (5,913,629) discloses (Figs. 1, 4 and 5) both of the writing tip (34) and the tip (actuator button 48) of the cap (upper barrel portion 14a) are fully retracted inside the elongated body (lower barrel portion 14b) and the cap (upper barrel portion 14a), respectively.

Therefore, it would have been obvious to the person of ordinary skill in the art to incorporate the teaches of "fully retracted tip" within the body of the pen since it is well-known in the art that most of the pen or fountain pen having retractable tip, which can be movable inside the body of the pen for protection when the pen is not in use.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Luu



MATTHEW LUU
PRIMARY EXAMINER